

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s): Takaaki AMANO
Serial No.: 09/863,877
Filed: May 23, 2001
For: **ADVERTISEMENT INFORMATION SUPPLYING SYSTEM**
Examiner: Jean D. Janvier
Group Art Unit: 3622
Confirmation No.: 9471
Attorney Docket No.: 100809-16253 (SCET 18.699)

June 2, 2008

SUBSTITUTE APPEAL BRIEF FOR APPELLANT

Board of Patent Appeals and Interferences
Assistant Commissioner for Patents
Washington, D.C., 20231

Sir:

Applicants herewith file this Substitute Appeal Brief in response to the Notification of Non-Compliant Appeal Brief mailed May 1, 2008.

On October 5, 2007, Applicants filed a Notice of Appeal and Appeal Brief appealing to the Board of Patent Appeals and Interferences from the Examiner's Decision, in the Official Action dated July 6, 2007, finally rejecting claims 1 and 4-10.

This Appeal follows a Notice of Appeal filed on December 20, 2006 and a corresponding Appeal Brief filed on February 14, 2007, appealing to the Board of Patent Appeals and Interferences from the Examiner's Decision, in the Official Action dated July 24, 2006, finally

rejecting claims 1 and 4-10. The Examiner issued the non-final Office Action dated July 6, 2007, in response to the previously filed Appeal Brief.

Since all requisite fees, including those for this Brief set forth in 37 C.F.R. § 41.20(b)(2), have already been paid in the previous Appeal, which was withdrawn by the Examiner's issuance of a new Office Action, Applicants submit that no additional fees are due at this time. However, any deficiencies may be charged to Deposit Account No. 50-1290.

I. Real party in interest

The real party in interest is Sony Computer Entertainment Inc., a Japanese corporation with offices at 1-1, Akasaka 7-chome, Minato-ku, Tokyo, Japan.

II. Related appeals and interferences

Upon information and belief, there are no other appeals or interferences, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status of claims

Claims 1 and 4-10 are pending.

Claims 2 and 3 have been canceled.

Claims 1 and 4-10 are rejected.

Claims 1 and 4-10 are appealed.

IV. Status of amendments

Appellant filed a response to the final Office Action of July 24, 2006, on October 18, 2006, including amendments to claims 1 and 4-10. The Advisory Action dated November 16, 2006, indicates that the amendments are entered. Appellant did not otherwise cancel or amend any of the claims that are the subject of this appeal.

V. Summary of claimed subject matter

Claim 1 recites an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) for displaying a point which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a computer network (figure 1, element 40). The system of claim 1 includes storage means (figures 1 and 2, element 10) for storing therein identification information of a customer (figure 2, element 22) and a point degree owned by the customer (figure 2, element 21) in relation to each other, and display point degree determining means for determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule. In the system of claim 1, said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent

display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 5 recites an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) for displaying a point which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a computer network (figure 1, element 40), comprising: storage means (figures 1 and 2, element 10) for storing (figure 2, element 22) thereinto identification information of a customer and personal information related to the customer in relation to each other; means for accepting the identification information of the customer from a terminal apparatus of the customer; means for acquiring the personal information related to the customer from said storage means, said personal information being related to the accepted identification information of the customer; and display point degree determining means for determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule; wherein said rule being that a point degree owned by the customer (figure 2, element 21) increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 8 recites a computer readable medium for causing a computer to function as an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) for displaying a point which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a computer network (figure 1, element 40), the computer readable medium having encoded thereon computer codes which when executed on a processor perform the steps of: storing identification information (figure 2, element 22) of a customer and a point degree owned by the customer (figure 2, element 21) in relation to each other; accepting the identification information of the customer from a terminal apparatus of the customer; acquiring the point degree owned by the customer related to the accepted identification information of the customer; and determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule; wherein said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 9 recites a computer readable medium for causing a computer to function as an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to

page 11, line 24) for displaying a point which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a computer network (figure 1, element 40), the computer readable medium having encoded thereon computer codes which when executed on a processor perform the steps of: storing identification information (figure 2, element 22) of a customer and personal information related to the customer in relation to each other; accepting the identification information of the customer from a terminal apparatus of the customer acquiring the personal information related to the customer, said personal information being related to the accepted identification information of the customer; and determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule; wherein said rule being that a point degree owned (figure 2, element 21) by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 10 recites a method of displaying a point in an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus

(figure 1, element 30) connected thereto via a computer network (figure 1, element 40), the method comprising the steps of: a) storing identification information (figure 2, element 22) of a customer and a point degree owned by the customer (figure 2, element 21) in relation to each other; b) accepting the identification information of the customer from a terminal apparatus of the customer; c) acquiring the point degree owned by the customer from said storage means, said owned point degree being related to the accepted identification information of the customer; d) determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule; wherein said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

VI. Grounds of rejection to be reviewed on appeal

1. Whether or not claim 4 is indefinite under 35 U.S.C. 112, Second Paragraph.
2. Whether or not claims 1, 5, 8, 9, and 10 comply with the written description and enablement requirements of 35 U.S.C. 112, First Paragraph.

3. Whether or not claims 1 and 4-10 are anticipated under 35 U.S.C. 102(b) based on United States Patent No. Patent 5,794,210 to Goldhaber (also referred to hereinafter as the “Goldhaber Patent”).

VII. Argument

1. Claim 4 is definite under 35 U.S.C. 112, Second Paragraph.

Claim 4 is rejected under 35 U.S.C. 112, Second Paragraph, in the Office Action dated July 24, 2006, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner asserts in the Office Action dated July 6, 2007, that claim 4 is inconsistent with a feature of claim 1 by stating that the point degree to be displayed is equal to zero, whereas claim 1 states that the point degree does not decrease to zero (Office Action of July 6, 2007; page 3, lines 14-16). However, claim 1 states that the display point degree does not decrease to zero *for the subsequent display of the advertisement information in response to the customer first selecting the advertisement*, and therefore does not indicate that the point degree *never* decreases to zero. Claim 4 recites that “a minimum value of the point degree to be displayed is equal to 0”, which is consistent with the feature of claim 1 relating to the adjustment to the display point degree for the first selection of the advertisement. Therefore claim 4 is not inconsistent as presented and Appellant respectfully requests that Board indicate that the claim is definite.

2. Claims 1, 5, 8, 9, and 10 satisfy the written description and enablement requirements of 35 U.S.C. 112, First Paragraph.

Claims 1, 5, 8, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing the written description requirement and not being enabled. With regard to the feature of claim 1 of

“the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement”, Applicants submit that figure 12, showing a “diagram for explaining an image of a point change rule as to a total gained-point number with respect to one banner advertisement” (Specification; page 6, lines 14-15), as well as the accompanying description on page 35, line 16, to page 37, line 5, and following, provide ample written description of this feature. In particular, the cited sections state:

For example, when the gained-point number is smaller than, or equal to 20, the highest point among the displayable points is indicated. ***Subsequently, the larger the gained-point number becomes, the smaller the displayed point degree becomes stepwise.*** Then, when the total gained-point number exceeds 100, the point as to this banner advertisement is no longer displayed.

(Specification; page 35, lines 5-11; emphasis added). The specification further states that “[i]f the user displays the same banner advertisement many times, then the displayed point (namely, gained-point number) is ***gradually*** decreased” (Specification; page 35, lines 5-11; emphasis added). Additionally, Figure 12 shows a display point number decreasing as the gained point number increases. As is apparent from Figure 12, the display point number does not decrease to zero immediately after the gained-point number rises above zero. Therefore, for at least the above reasons, claim 1, as well as claims 5, 8, 9, and 10, are adequately supported by the written description of the specification as filed.

With regard to the rejections of claims 1, 5, 8, 9, and 10, as not being enabled, the Examiner provides a generalized rejection which does not provide any basis for Applicants to effectively argue that the claims are enabled, or to clarify the subject matter of the claims or the specification. Initially, Applicants point out that several of the terms which the Examiner objects

to do not appear in the claims, for instance, “points themselves”, “point-appearing time”, and “point-appeared time”. Furthermore, the Examiner provides no specific citation to any confusing language or sections of the specification. Applicants direct the Appeals Board’s attention to the portions of the specification discussing the point degree, for instance page 35, line 16, to page 36, line 14. Applicants submit that the claims as presented comply with the enablement requirement, and therefore respectfully request that the rejection be withdrawn.

3. Claims 1 and 4-10 are patentable under 35 U.S.C. 102(b) over the Goldhaber Patent.

The Examiner has repeatedly admitted that the Goldhaber Patent does not disclose the feature of claim 1 of “the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement” (Office Action dated July 24, 2006; page 9, lines 14-17). The Examiner formerly relied on another reference in rejecting these claims under 35 U.S.C. 103(a). The Examiner now inexplicably bases this rejection solely on the Goldhaber Patent, thereby forcing Applicant to prepare and file another Appeal Brief, and thereby causing additional delay in examination of this application.

The Examiner again essentially admits, on page 9 of the Office Action dated July 7, 2007, that the Goldhaber Patent does not disclose or suggest the feature of claim 1 quoted above. The Examiner acknowledges that the Goldhaber Patent discusses deactivating a Cybercoin. The Examiner cites to the Goldhaber Patent at a section which states:

if the consumer did everything correctly, the attention brokerage server 106 updates the consumer's account to credit (or direct pay) the consumer the monetary value represented by the activated CyberCoin 62 (FIG. 12, block 230), updates its database to

inactivate this particular CyberCoin (to prevent the consumer from receiving additional compensation by merely successively repeating the same process for the same ad) (FIG. 12, block 232), and returns with a success code.

(Goldhaber; col. 17, lines 45-53; emphasis added). The Examiner further asserts that “when the user clicks on the ad for the first time, the value of the Cybercoin or display point degree is greater than zero (the display point degree does not decrease to zero at this state)” (Office Action dated July 7, 2007, at page 9, lines 13-15). However, this statement is completely unsupported, and furthermore is at odds with the various other characterizations of the Goldhaber Patent in the Office Action dated July 7, 2007, and elsewhere. Since the Examiner has admitted that the Goldhaber Patent does not disclose “the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement”, the Examiner has not made a *prima facie* showing of anticipation. Therefore, the rejection of claims 1 and 4-10 based on the Goldhaber Patent should be withdrawn.

CONCLUSION

Claims 1 and 4-10 are patentable over the Goldhaber Patent. Accordingly, it is respectfully submitted that the Examiner erred in rejecting claims 1 and 4-10 and a reversal of such rejections by this Honorable Board is solicited.

Respectfully submitted,

/Brian E. Hennessey/

Brian E. Hennessey

Reg. No. 51,271

CUSTOMER NO.: 026304
Telephone No.: (212) 940-6311
Fax No.: (212) 940-8986/87
Docket No.: 100809-16253 (SCET 18.699)
BEH:fd

VIII. Claims Appendix

- I. An advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, comprising:
 - storage means for storing therein identification information of a customer and a point degree owned by the customer in relation to each other;
 - means for accepting the identification information of the customer from a terminal apparatus of the customer;
 - means for acquiring the point degree owned by the customer from said storage means, said owned point degree being related to the accepted identification information of the customer; and
 - display point degree determining means for determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein
 - said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and
 - the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.
4. The advertisement supplying system as claimed in claim 1 wherein:
 - a minimum value of the point degree to be displayed is equal to 0.

5. An advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, comprising:

storage means for storing thereinto identification information of a customer and personal information related to the customer in relation to each other;

means for accepting the identification information of the customer from a terminal apparatus of the customer;

means for acquiring the personal information related to the customer from said storage means, said personal information being related to the accepted identification information of the customer; and

display point degree determining means for determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

6. The advertisement supplying system as claimed in claim 5 wherein:
the personal information related to the customer corresponds to information as to at least any one of a sex of the customer, an age thereof, and a taste thereof.
7. The advertisement supplying system as claimed in claim 1 wherein:
a sort of point degree selected by the display point degree determined means; and
the display point degree determined by said display point degree determining means is selected from the sort of point degrees selected by the display point degree means.
8. A computer readable medium for causing a computer to function as an advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, the computer readable medium having encoded thereon computer codes which when executed on a processor perform the steps of:
storing identification information of a customer and a point degree owned by the customer in relation to each other;
accepting the identification information of the customer from a terminal apparatus of the customer;
acquiring the point degree owned by the customer related to the accepted identification information of the customer; and
determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

9. A computer readable medium for causing a computer to function as an advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, the computer readable medium having encoded thereon computer codes which when executed on a processor perform the steps of:

storing identification information of a customer and personal information related to the customer in relation to each other;

accepting the identification information of the customer from a terminal apparatus of the customer

acquiring the personal information related to the customer, said personal information being related to the accepted identification information of the customer; and

determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

10. A method of displaying a point in an advertisement supplying system which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, the method comprising the steps of.

a) storing identification information of a customer and a point degree owned by the customer in relation to each other;

b) accepting the identification information of the customer from a terminal apparatus of the customer;

c) acquiring the point degree owned by the customer from said storage means, said owned point degree being related to the accepted identification information of the customer;

d) determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

IX. Evidence Appendix

No evidence was submitted to or entered by the Examiner during prosecution of this application.

X. Related Proceedings Appendix

No appeals or interferences, which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal, are identified in section II of this brief, and therefore there are no decisions rendered by a court or the Board in any proceeding included in this section.